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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

49581/P024US/10006096

Application Number

09/552,760-Conf.
#3104

Filed

April 18, 2000

First Named Inventor

Kirk B. Ashby et al.

Art Unit

2684

Examiner

P. Tran

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant /inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/96)

☐

attorney or agent of record.

Registration number _____

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

42,203



Signature

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February 1, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐*Total of 1 forms are submitted.



Docket No.: 49581/P024US/10006096
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kirk B. Ashby et al.

Application No.: 09/552,760

Confirmation No.: 3104

Filed: April 18, 2000

Art Unit: 2685

For: SYSTEM AND METHOD FOR FREQUENCY
TRANSLATION USING AN IMAGE REJECT
MIXER

Examiner: P. Tran

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AFTER FINAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed concurrently with a Notice of Appeal. The review is requested for the reasons stated below.

REASONS FOR REQUESTED PRE-APPEAL REVIEW

I. Issues

Claims 1, and 3-38 are pending in the present application. Claims 1, 3-4, and 8-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of U.S. Patent No. 5,661,485 (hereinafter, Manuel) and further in view of U.S. Patent No. 6,400,416 (hereinafter, Tomasz). Claims 5-7 and 34-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the modified communication system of the AAPA and Tomasz and further in view of U.S. Patent No. 5,950,119 (hereinafter, McGeehan). Applicant respectfully submits that the outstanding claim

rejections are improper, and thus requests pre-appeal review of the rejected claims in light of the remarks presented herein.

II. Rejections under 35 U.S.C. § 103(a)

A. Rejections over *AAPA* in view of *Manuel* and further view of *Tomasz*

Claims 1, 3-4, and 8-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *AAPA* in view of *Manuel* and further in view of *Tomasz*. Applicant respectfully submits that the rejection is improper for the reasons discussed below, and thus request that the review panel reconsider and withdraw the rejection.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143. Applicant, respectfully submits that the rejection of record does not meet these criteria.

Independent Claims 1, 15, and 30

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to provide *Manual*’s single-sideband/image reject mixers to the mixers of *AAPA* to provide a lower inherent noise output and remove unwanted image signal. *See* Office Action mailed on December 1, 2005, page 3. However, Applicant has shown that there is no basis in either the references or the knowledge generally available to one of ordinary skill in the art for the Examiner’s asserted motivation to combine the references because *AAPA* already provided output signals of the desired quality. *See* Applicant’s Response submitted August 31, 2005 at pages 11 to 12.

The Examiner further asserts that “it would have been obvious to one of ordinary skill in the art to provide such circuitry arrangement on a single IC substrate, as disclosed in *Tomasz*, to the modified communication system of Applicant’s Admitted Prior Art to provide such compact integrate [sic] device that can easily be implement [sic] in a receivers [sic].” Office Action mailed on December 1, 2005, page 3. However, Applicant has pointed out that

this motivation comes from the Applicant's own specification, and that the Examiner used impermissible hindsight to articulate the asserted motivation to combine these references. Moreover, Applicant has shown that the combination was improper because the references teach away from the proposed combination. *See* Applicant's Response submitted August 31, 2005 at pages 12-13.

Moreover, Applicant has also shown that there is not a reasonable expectation of success for the Examiner's proffered combination as required to establish *prima facie* obviousness under 35 U.S.C. § 103. *See* Applicant's Response submitted August 31, 2005 at page 14.

Dependent Claim 3-4, 8-14, 16-29, and 31-33

Dependent claims 3-4, 8-14, 16-29, and 31-33 depend either directly or indirectly from, and inherit all of the limitations of their respective independent claims 1, 15, 30, shown above to be allowable over the applied art. Therefore, claims 3-4, 8-14, 16-29, and 31-33 are allowable, at least, because of their dependence from claim 1, 15, and 30. Moreover, claims 3-4, 8-14, 16-29, and 31-33 contain patentable subject matter that would allow them to stand on their own.

For example, Applicant has shown that the applied references fails to teach or suggest the limitations of claims 11, 12, 24, 31, and 32. *See* Applicant's Response submitted August 31, 2005 at pages 16-17. Accordingly applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

With respect to the rejection of claims 8-10, and 23, Applicant has pointed out that the Examiner has not articulated a motivation for the combination, and that there is no motivation for one of ordinary skill in the art to modify the discrete component system of AAPA (against conventional thinking in the television industry) to include an amplitude manipulator disposed on an integrated chip as asserted by the Examiner. *See* Applicant's Response submitted August 31, 2005 at page 15.

With respect to claims 11-13, 24-25, and 31-32, the Examiner asserts that the modified *AAPA* and *Tomasz* further disclosed a filter coupled to said first single sideband mixer and disposed on a common IC substrate. Office Action, pages 4-5. The Examiner

does not provide any motivation for one of ordinary skill in the art to make the proposed combination. Further, there is nothing in the applied references to teach or suggest that the discrete component system of *AAPA* could be modified with the filter and asserted mixers of *Manuel* and disposed on the IC substrate of *Tomasz* with a reasonable expectation of success, as required to establish a prima facie case of obviousness under 35 U.S.C §103. See Applicant's Response submitted August 31, 2005 at page 15.

With respect to claims 14, 17-20, 23, 26-29, and 33, there is no motivation in the references for the Examiner's proposed combinations, and the Examiner does not provide any motivation for one of ordinary skill in the art to make the proposed combinations. Moreover, there is no reasonable expectation of success for the Examiner's proposed combinations. See Applicant's Response submitted August 31, 2005 at pages 17-19.

B. Rejections over *AAPA* in view of *Tomasz* and further in view of *McGeehan*

On page 5 of the Office Action claims 5-7 and 34-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *AAPA* in view of *Tomasz* and further in view of *McGeehan*. Applicant respectfully submits that the rejection is improper for the reasons discussed below, and thus request that the review panel reconsider and withdraw the rejection.

With respect to claims 5-7 and 34-38 the Examiner asserts that "it would have been obvious to one of ordinary skill in the art to provide such combiner, as disclosed in *McGeehan*, to the modified communication system of the Applicant's Admitted Prior Art and *Tomasz* to provide an accurate gain and phase matching of the paths through the first and second mixers that can be used to achieve a high degree of cancellation of the unwanted image signal." Office Action mailed on December 1, 2005, page 5-6. However, the Applicant has pointed out that there is no motivation for one of ordinary skill in the art to make the Examiner's proffered combination. In fact, Applicant has shown that the Examiner uses impermissible hindsight gleaned from the Applicant's specification to find the motivation to combine the references. See Applicant's Response submitted August 31, 2005 at pages 20-21.

Moreover the Examiner's proposed combination relies upon a second phase shifter that the Examiner asserts is disclosed in fig. 4/no. 58, in *Manual*, in order to meet the claim

limitations. However, Applicant points out that Manual actually discloses fig. 4/no. 58 as a power divider instead of a phase shifter. *See* Manual, column 4, line 11, and Applicant's Response submitted August 31, 2005 at page 20.

III. Summary

In view of the above, Applicant respectfully requests that the review panel reverse the outstanding rejections of record and pass this application it issue. The required fee for the Notice of Appeal filed with this request is attached. If any additional fee is due please charge our Deposit Account No. 06-2380, under Order No. 49581/P024US/10006096 from which the undersigned is authorized to draw.

Dated: February 1, 2006

Respectfully submitted,

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